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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/798,217	03/09/2004	Roy C. Wiley	ZIM0420	3495
7590 10/16/2007				
John F. Hoffman, Esq. BAKER & DANIELS LLP Suite 800 111 East Wayne Street Fort Wayne, IN 46802				
			EXAMINER PRIDDY, MICHAEL B	
			ART UNIT 3733	PAPER NUMBER
			MAIL DATE 10/16/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/798,217

Applicant(s)

WILEY ET AL.

Examiner

Michael B. Priddy

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03 July 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 8-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 8-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Murray (Reference U.S. Patent "4,627,434").

Murray discloses an orthopaedic injection restrictor apparatus comprising: a nozzle (10) including an elongated portion (see Figure 1 below); and an orthopaedic plug (28) including a first portion (see Figure 3 below) releasably engaged with the elongated portion of the nozzle (10) and further including a plurality of flaps (30) extending radially outwardly from said first portion (col. 3, lines 49-68 and col. 4, lines 1-10). At least one of the flaps (30) is resiliently hinged to the first portion of the orthopaedic plug (28; col. 3, lines 52-60 and col. 4, lines 15-28). The elongated portion of the nozzle (10) defines a sleeve (12) and the first portion of the orthopaedic plug partially extends into the sleeve (see Figure 1-3 below). The first portion of the orthopaedic plug (28) includes a boss (see Figure 3 below) positioned within the sleeve. The apparatus further comprises a plurality of graduations (22) on the elongated portion of the nozzle (10; col.3, lines 40-43). The plurality of graduations (22) extends linearly

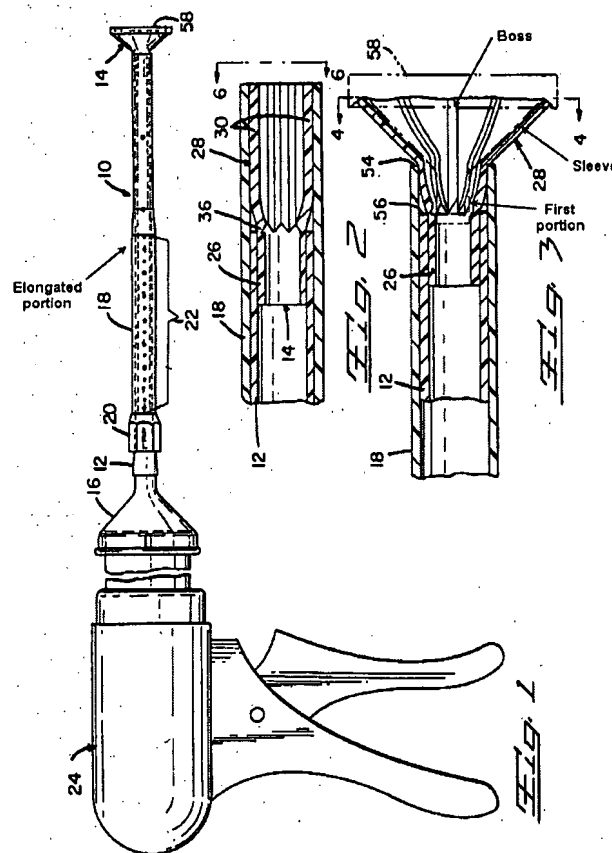
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away from at least one of the flaps (col. 3, lines 40-43). The elongated portion of the nozzle (10) includes a flexible portion (14). The first portion of the orthopaedic plug (28) defines a sleeve and the elongated portion of the nozzle (10) extends into the sleeve. The apparatus further comprises a plurality of graduations on the elongated portion of the nozzle (10; col.3, lines 40-43); wherein the elongated portion of the nozzle (10) defines a sleeve, the first portion of the orthopaedic plug (28) extends into the sleeve, the plurality of graduations (22) extends linearly away from at least one of the flaps, and the elongated portion of the nozzle (10) includes a flexible portion (14). The first portion of the orthopaedic plug includes a boss (see Figure 3 below) within the sleeve. The apparatus further comprises: a plurality of graduations (22) on the elongated portion of the nozzle (10); wherein the first portion of the orthopaedic plug (28) defines a sleeve and the elongated portion of the nozzle (10) extends into the sleeve, the plurality of graduations (22) extends away from at least one of the flaps (30), and the elongated portion of the nozzle includes a flexible portion.

Murray further discloses an apparatus comprising: means for injecting the substance into the cavity; and means, releasably engaged with the injecting means, for plugging the cavity (col. 3, lines 44-48). The injecting means and the plugging means form a means for ejecting the plugging means from the injecting means simultaneously with injecting the substance into the cavity (col.2, lines 20-43 and col. 3, lines 44-48). The injecting means includes a means for setting the depth (col. 3, lines 32-43).

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Murray further discloses a method comprising the steps of: injecting the substance into the cavity; and ejecting the plug into the cavity simultaneously with the ejecting step (col.2, lines 20-43).



### ***Response to Arguments***

Applicant's arguments filed 07/05/2007 have been fully considered but they are not persuasive.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., a central portion directly *releasably* engaged with the elongated portion of the nozzle) are not recited in the rejected claim(s). Although the claims are interpreted in

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light of the specification, limitations from the specification are not read into the claims.

See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Additionally, it appears Applicant is relying on different elements from the Examiner when interpreting the teachings of Murray in view of the pending claims. The Examiner has relied on any of the elements 80, 82 or 84 mentioned by Applicant on page 5 of the response. The Examiner maintains the elements of Murray referred to in the above rejection under 35 U.S.C. 102(b) teach all of the limitations of the claims as presently amended.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

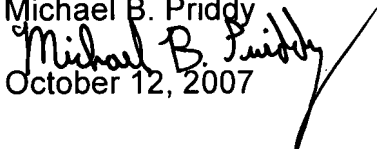
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael B. Priddy whose telephone number is 571-272-2243. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Michael B. Priddy  
  
October 12, 2007

  
EDUARDO C. ROBERT  
SUPERVISOR, PATENT EXAMINER